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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 00-1312-C)

In the Application of:

Michael S. Kopreski

Patent No. 6,759,217

Filed: September 28, 2001

For: Method Enabling Use of Extracellular RNA
Extracted From Plasma or Serum to Detect,
Monitor or Evaluate Cancer

Before the Examiner:
F. Lu

Group Art Unit: 1655

Confirmation No.:
5477

TRANSMITTAL LETTER

Mail Stop Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In regard to the above-identified application:

1. We are transmitting herewith the attached
 - a. Request for Reconsideration
 - b. Return Receipt Postcard
2. With respect to additional fees:
 - a. A check in the amount of \$200.00 is enclosed.
4. Please charge any deficiency in the amount due, or credit any overpayment, to Deposit Account No. **13-2490**. A duplicate copy of this sheet is enclosed.
5. **CERTIFICATE OF MAILING UNDER 37 CFR § 1.8:** The undersigned hereby certifies that this Transmittal Letter and the papers, as described in paragraph 1 herein-above, are being deposited with the United States Postal Service with sufficient postage as "First Class Mail" in an envelope addressed to: Box Patent Ext., Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on this 5th day of **August, 2004**.

By:

Kevin E. Noonan
Reg. No. 35,303



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**REQUEST FOR RECONSIDERATION
UNDER 37 C.F.R. § 1.705(d)**

Mail Stop Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Responsive to the determination of the Patent Term Adjustment under 35 U.S.C. § 154(b) mailed on June 17, 2004, Applicant submits this Application for Reconsideration under 37 C.F.R. § 1.705(d). Applicant also submits the required fee under 37 C.F.R. § 1.18(e) along with this Request for Reconsideration.

A determination of the Patent Term Adjustment was mailed with the Issue Notification on June 17, 2004. This Determination stated that the Patent Term Adjustment would increase the term of the patent by 0 days. This determination was calculated by comparing: (1) the number of days attributed to Office delay (227 days); and (2) number of days attributed to Applicant delay (allegedly 253 days). Since the alleged number of days attributed to Applicant delay outnumber the days attributed to Office delay, the Office concluded that the Patent Term Adjustment was 0 days. The Applicant submits this Request for Reconsideration to request reconsideration of 120 days charged as Applicant delay and reinstatement of these 120 days subtracted when calculating the patent term adjustment.

The paper filed that gave rise to the alleged 120 day delay attributed to the Applicant was an Information Disclosure Statement. The Information Disclosure Statement was initially filed

on July 22, 2003, the same day the issue fee was paid. The July 22, 2003 filing also included the statement that “the references cited in the accompanying Information Disclosure Statement were not known to anyone under the duty of disclosure set forth in 37 C.F.R. § 1.56 more than three months prior to the date that this paper and the accompanying Information Disclosure Statement are submitted.” Over *seven months* later, on March 4, 2004, the Office informed Applicants that the Office had not considered the Information Disclosure Statement filed July 22, 2003 because the Applicant’s statement accompanying that Information Disclosure Statement did not comply with 37 C.F.R. § 1.97(e). On April 26, 2004, Applicants revised the Applicant’s Statement as follows:

That no item of information was contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application , and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any person designated in Sec. 1.56(c) more than three months prior to the date that this paper and the accompanying Information Disclosure Statement were originally submitted on July 22, 2003.

On June 6, 2004, the Office rejected this revised statement, but on June 29, 2004, the Office entered the Information Disclosure Statement and signed Applicant’s Form 1449A/PTO.

Presumably because of the Information Disclosure Statement filed July 22, 2003, the Office has charged the Applicant with 120 days of delay under C.F.R. § 1.704(c)(10). However, the Applicants submit that such a delay is excessive considering the simple matter at issue. By filing the Information Disclosure Statement, the Applicant was merely asking the Office to consider one additional reference. It took the Patent Office over 11 months to complete this simple task. Not only that, it took the Office over 7 months to initially inform the Applicant that the Information Disclosure Statement would not be considered due to an asserted technical problem with the Applicant’s Statement accompanying the Information Disclosure Statement. Because it took the Office so long to address the technical aspect of the Information Disclosure Statement submission, the Applicant has suffered a 4-month reduction in patent term adjustment for an “Applicant delay” that was in no way Applicant’s fault or responsibility. Had the Patent Office addressed the asserted technical deficiency in the Information Disclosure Statement submission in a more timely manner, the total number of days of Applicant delay would likely be fewer than the number of days of Office delay, entitling the Applicant to an adjustment of patent term. Due to the ease of the task of reviewing the July 22, 2003 Information Disclosure Statement submission for the asserted technical deficiencies as well as on the merits, Applicant

submits that charging him with *4 months* of delay is unreasonable and requests reinstatement of all 120 days charged as Applicant delay. In the alternative, the Applicant requests reinstatement of a reasonable portion of the 120 days charged as Applicant delay, since the task of informing the Applicant of the technical problem with the Applicant's Statement could have been completed in less than one month.

Thus, because the paper filed after the Notice of Allowance was an Information Disclosure Statement that contained merely an asserted technical error in the Applicant's Statement that could have been identified to the Applicant in a timely manner, Applicant respectfully requests reconsideration of the patent term adjustment and reinstatement of the 120 days subtracted from the adjustment.

We note for the Office's convenience that this patent, 6,759,217, is subject to a terminal disclaimer whereby the term of the patent beyond the expiration of U.S. Patent No. 6,329,179 is disclaimed.

If a telephone conference would expedite favorable consideration of this Request for Reconsideration, please call Applicant's undersigned representative at 312-913-0001.

Respectfully submitted,

By: _____

Kevin E. Noonan
Registration No. 35,303

Date: August 5, 2004